

III. REMARKS

1. Claims 9 and 15-17 are proposed to be amended.

Claim 9 is amended to correct the noted informality.

Claims 15-17 are amended to address the 35 U.S.C. §101 rejection.

2. Claims 1, 3-5, 7-10, 12 and 14-15 are not unpatentable under 35 U.S.C. §103(a) by 3GPP in view of Zahariev (U.S. 6,035,104).

Claim 1 is directed to transferring a "multi media message" in a "multimedia messaging system." In Applicant's invention, a first message is transmitted from the terminal to the multimedia messaging center (MMC). This first message requests the MMC to transmit a "notification" message to the terminal for "multimedia" messages addressed to the terminal, that have "arrived" at the MMC and for which the terminal has not received any notification message. The first message allows the user to define a selection criteria to "limit" information sent in "response" to the first message.

This is not disclosed by the combination of 3GPP in view of Zahariev.

First, Zahariev is not concerned with and does not disclose or suggest a "multimedia messaging center". Zahariev only deals with "e-mail."

Also, Zahariev is not concerned with transmitting a "notification" about a "multimedia message" that the terminal has not yet been notified about. Rather, Zahariev is only concerned with giving the "subscriber an option to have the message

forwarded either by e-mail or fax to a specific location." (Col. 3, line 64 to Col. 4, line 1.)

In Zahariev the email is first forwarded to the subscriber (Col. 3, lines 49-51.) Then, if there is a match between criteria and message characteristics, the system alerts the subscriber using a paging signal. (Col. 3, lines 52-55). The subscriber can then have the e-mail sent to an "alternate mail address". (Col. 3, lines 55-60).

Thus, Zahariev is merely sending a notification about an e-mail that has already been received and delivered to the users primary email address. The option Zahariev presents is the ability to have an email sent to another address, after the user is notified that the email is received and was already delivered to the primary address. The user has to call in to select the means of alternate delivery. (Col. 4, lines 9-14). This is not the same as what is claimed by Applicant where the "first message" is a request for notifications on messages that have arrived at the "multimedia messaging center" and for which the "terminal has not received a notification message yet".

Thus, Zahariev in view of 3GPP cannot disclose or suggest that the first message, as recited by Applicant in the claims, comprises an option to define a selection criterion to limit information to be sent in response to the first message.

Therefore, claims 1, 8, 9, 10, 15 and 17 are not disclosed or suggested by the combination of 3GPP in view of Zahariev under 35 U.S.C. §103(a).

3. It is respectfully submitted that there is no legal motivation to combine 3GPP with Zahariev. In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), there must be

some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. There must also be a reasonable expectation of success, and the reference(s), when combined, must teach or suggest all of the claim limitations. (See M.P.E.P. §2142). As noted above, the combination of 3GPP and Zahariev does not disclose or suggest each feature of Applicant's invention as claimed.

Neither 3GPP nor Zahariev provide any suggestion or motivation to be combined or modified as proposed by the Examiner. Applicant's invention as recited in the claims is directed to transferring a multimedia message in a multimedia messaging system. Zahariev does not deal with multimedia messaging, but rather only e-mail and e-mail services. A multimedia messaging center is not the same as a basic email server. One would not look to combine a teaching related to a multimedia messaging system with a basic e-mail server or system. Nothing in either 3GPP or Zahariev suggests such a combination.

The Examiner's proposition that Applicants' invention would be obvious as recited in the claims is not supported by the factual contents of 3GPP and Zahariev.

Motivation for purposes of 35 U.S.C. §103(a) requires that the reference itself and/or the knowledge generally available to one of skill in the art provide the requisite motivation or suggestion to modify the reference. When "the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference". In re Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). The passage cited by the Examiner do not relate to requesting a multimedia center to send "notifications"

on messages, whose notifications have not already been sent/received. Rather, these passages of Zahariev, discuss requesting an actual delivery of the email to an "alternate" location, after the email has already been delivered to one location.

In Applicant's invention, the first message transmitted from the terminal to the multimedia messaging center requests the center to transmit a "notification message" to the terminal for multimedia messages that have arrived at the center for which the "terminal has not received a notification message."

Thus, The Examiner's proposition that Applicants' invention would be obvious as recited in the claims is not supported by the factual contents of 3GPP and Zahariev and the Examiner is requested to provide an indication as to where any such teaching, suggestion or motivation appears in the reference. Absent such a teaching, it is submitted that a *prima facie* case of obviousness over 3GPP and Zahariev under 35 U.S.C. §103(a) is not established.

4. Applicant respectfully notes that 3GPP and Zahariev have been combined improperly. References may be combined under 35 U.S.C. §103(a) only if the references are analogous art. In this case 3GPP and Zahariev are not analogous art. A reference is analogous art if:

- 1) The reference is in the same field of endeavor as the applicant's, or
- 2) The reference is reasonably pertinent to the particular problem with which the applicant is concerned.

While 3GPP relates to multimedia messaging services, Zahariev does not. Zahariev only relates to email and email servers.

Zahariev is concerned with delivering an email message to an "alternate" location. (Col. 3, lines 55-58). Applicant's invention is, on the other hand, directed to transferring a multimedia message in a multimedia messaging system using a notification message. Thus, Zahariev is not reasonably pertinent to the particular problem with which Applicant was concerned.

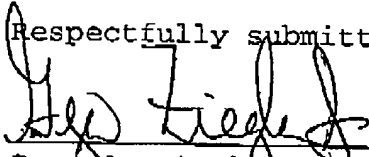
Thus, 3GPP and Zahariev cannot be properly combined for purposes of 35 U.S.C. §103(a).

5. If the Examiner is not satisfied as to the patentability of Applicant's invention as claimed, entry of this amendment and response is respectfully solicited for purposes of the Appeal which is likely to result.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,


Geza C. Ziegler, Jr.
Reg. No. 44,004

20 Jan 2006
Date

Perman & Green, LLP
425 Post Road
Fairfield, CT 06824
(203) 259-1800
Customer No.: 2512

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Date: Jan. 20, 2006 Signature: Meaghan Baye
Printed Name: Meaghan Baye